

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the Amendment to the Claims, claim 24 is amended to make it clear that the set of floor panels are configured to form one and a same floor covering. Support for this amendment is found in the specification on page 11, lines 9-18, and in figure 1 of the drawings.

Claim 24 is also amended to recite that the coupling parts of the first and second types of floor panels cooperate with one another so as to form the floor covering. This amendment is considered to make explicit that which was implicit in the limitation of the description of the coupling parts. Support for this amendment is found in the specification on page 11, line 24 through page 12, line 14, and in figures 1-3 of the drawings.

Lastly, claim 24 is amended to clarify that each of the floor panels provided in the package is "individual." Again, this amendment is provided to make explicit that which was implicit in the claim since it was plainly recited that the set of floor panels comprises a plurality of floor panels that are each arranged to lock one another via the coupling parts that each panel defines, thereby demonstrating that the set of floor panels contains a plurality of individual floor panels for forming a floor covering. Support for this amendment is clearly found in the figures and the corresponding sections in the specification.

It is submitted that the amendment to claim 24 does not introduce new subject matter, and that there is clear support in the originally-filed application for the limitations described therein.

Entry of the amendment to the claims is respectfully requested in the next Office communication.

2. Rejection of claims 24-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*) and U.S. patent 4,479,333 (*Hendrich*)

Reconsideration of this rejection is respectfully requested in view of the amendment to claim 24 from which the remaining claims depend, and the following observations.

As a precursor, it will be noted that the amendment to claim 24 is provided to clarify that the recited set of floor panels is distinguished as forming a floor covering which is considered in contradistinction to a structural panel of the type taught by *Meckstroth*. Moreover, claim 24 is amended to indicate that the coupling parts of the first and second types of floor panels, in combination with the fact that they together can form a floor covering, cooperate with one another. This particular feature of claim 24 is neither disclosed nor suggested by any of the teachings of *Meckstroth*, *Haffner* and *Hendrich*. Lastly, claim 24 clarifies that the set comprises a plurality of individual floor panels that are provided in a single package. This conveys that the floor panels of the single package can be coupled or assembled with one another by an installer when forming a floor covering.

In the following discussion, the applicant submits modified remarks to earlier remarks filed on September 28, 2006 in view of the amendment to the claims, and further addresses the examiner's response to such earlier remarks in the outstanding Office action.

First, the applicant respectfully disagrees with the assumption in the rejection that one skilled in the art would consider the structural panel of *Meckstroth* as the equivalent of the floor panels for a floor covering of the pending claims. It is asserted that one having skill in the art of installing floor panels or construction materials would readily recognize that a floor covering naturally "covers" structural panels or similar structural building members, and in no manner functions as a structural element itself. The idea that the claimed floor covering panel does not constitute a

“structural” panel of the type described by *Meckstroth* will be elucidated when comparing the construction and thickness of the structural panel of *Meckstroth* and the floor covering panel of *Haffner*.

Contrary to the rejection in the action, *Meckstroth* does not disclose or suggest a “set” of floor panels for forming a floor “covering” having a decorative layer. Instead, it is clear from *Meckstroth* that it relates to “structural” panels for building components (col. 2, lines 14-18). As explained by *Meckstroth*, the structural panels are for use in buildings such as modular dwelling units, housing sections, or building panels which are provided for forming connections between modules (col. 1, lines 11-15). One skilled in the art would readily recognize that using the structural panel of *Meckstroth* would be unsatisfactory as a floor covering panel.

While it is true that *Meckstroth* indicates that the structural panel thereof may be used “as floor panels, wall panels, ceiling panels or roof panels,” it is also readily evident in view of the entire disclosure of *Meckstroth* that the structural panel is of the very type that would be covered by floor covering panels (col. 2, lines 53-56).

Using the structural panel of *Meckstroth* as a floor covering would be akin to using a brick wall as a floor covering. While a structural panel or brick wall could be used as a floor covering, one skilled in the art would understand that such robust and thick construction items would be unsatisfactory, undesirable and burdensome for covering an already existing floor which is presumably already formed from some sort of structural element. In short, one skilled in the art would readily recognize that it makes no sense to redundantly install a structural panel over another existing structural panel, as suggested in the rejection.

As is well understood, there must be some reasonable expectation of success in order to show obviousness, and it is submitted that the action fails to show how it would be reasonable to cover a floor with a structural panel of *Meckstroth*. Moreover, as will be shown in the following discussion on the proposed combination of *Meckstroth* and *Haffner*, there is no reasonable expectation that one skilled in the art

would devise the set of floor covering panels of the pending claims since a combination of the teachings *Meckstroth* and *Haffner* would not successfully result in a floor panel having all of the recited features of the claimed floor covering panels.

Turning to the incompatible structural differences in the teachings of *Meckstroth* and *Haffner*, *Meckstroth* requires that each structural panel includes a vertical frame member (12), an outer skin formed by a sheet of rough-sawn exterior plywood scored at spaced intervals to receive horizontally spaced battens (14), an inner skin formed of a sheet of dry wall (16), and a polyurethane foam core filling the space between the sheet (18) (col. 2, lines 21-36). A tubular bracket (30) is required to connect adjacent structural panels.

Meckstroth particularly states that the frame member is preferably formed from a standard two-by-four (4-5 cm X 9-10 cm) or similarly sized structure (col. 4, lines 14-21). Taking into account that the plywood sheet and the dry wall sheet each most likely has a thickness of at least 1 cm, and the aforementioned thickness of the frame members, it is clear from the construction of the structural panels of *Meckstroth* that the total thickness of such panels would be on the order of at least 12 cm.

Obviously, from the robust construction of the structural panels of *Meckstroth*, the skilled artisan would understand that in no way would the panel of *Meckstroth* be suitable for forming a floor covering. The fact that the structural panels of *Meckstroth* could be used or modified with the teachings of *Haffner* does not render the pending claims obvious unless these references suggest the desirability of the combination.

While *Haffner* relates to a laminate flooring, it does not relate to a structural panel. There is no suggestion in *Meckstroth*, *Haffner* or *Hendrich*, or sufficient rationale articulated in the office action that shows how one skilled in the art would be motivated to modify the structural panel of *Meckstroth* with a decorative layer of the type taught by *Haffner*. Certainly, it is well understood that the teachings of the prior art must be considered as a whole, and it is plain in view of the disclosures of

Meckstroth and *Haffner* that there is no desirability to include a decorative layer on the structural panel of *Meckstroth*.

In response to the applicant's previous remarks, the examiner argues that the construction of the structural panel according to *Meckstroth* shown in figure 1 resembles the construction of the floor panel of *Haffner* shown in figure 2. While it is correct to observe that the construction of the structural panel of *Meckstroth* bears a resemblance to the floor panel of *Haffner*, the depiction of the floor panel of *Haffner* is found to be misleading in its actual size and thus application in the rejection.

In observing the drawings of *Meckstroth* and *Haffner*, the depiction of the structural panel of *Meckstroth* in figure 1 appears to proportionally depict the features of the structural panel, whereas the depiction of the floor covering panel in figure 2 of *Haffner* is schematic and merely exemplary. Keeping in mind the probable thickness of the structural panel of *Meckstroth*, it is clear in observing *Haffner* that the size of the floor panel taught therein is substantially different in size and application from the structural panels required by *Meckstroth*. Namely, the floor panel of *Haffner* is much thinner than the structural panel of *Meckstroth*, and as such is directed to a considerably different application from being a structural panel.

The thin structure of the floor panel of *Haffner* is actually suited for covering a structural panel of *Meckstroth* or other similar structural building member known to those skilled in the art. As strongly evidenced by the floor panel dimensions, *Haffner* teaches that the floor panel has a thickness of about 0.610 to about 0.813 cm (col. 11, lines 35-36). Of course, one skilled in the art would readily recognize the desirability in providing a substantially thin panel for a floor covering since it would be undesirable to provide a much thicker panel thereby resulting in a considerable reduction in headspace. In other words, one skilled in the art understands that a floor covering is not to substantially impact the height of a room in which it is installed, as would be the case if the modified structural panel of *Meckstroth* were used.

The floor panel of *Haffner* comprises a dimensionally stable substrate as a core as opposed to the foam core taught by *Meckstroth*. Further, the layers (14, 16) are a decorative surface and a backing layer, respectively. As explained in *Haffner*, the decorative layer (14) is a conventional surface layer commonly used in flooring panels, and preferably includes three resin impregnated paper layers (28, 30, 32) (*see generally* col. 5). Likewise, the backing layer (16) includes some paper layers. There is no frame member of the type taught by *Meckstroth* in the floor panel of *Haffner*.

One skilled in the art would readily understand that the paper layers of *Haffner* are not structurally strong and must be applied to a dimensionally stable core. Moreover, one skilled in the art would readily understand that a dimensionally stable core is distinguished from a foam core which is not considered to be sufficiently dimensionally stable to allow for the lamination of paper layers thereon and to provide sufficient structure to withstand walking thereover as in a floor covering.

In observing the paper layers used to form the decorative layer (14) and the backing layer (16), one skilled in the art would readily recognize that these paper layers are known to have a thickness in a range of 0.2 to 0.3 millimeters. The skilled artisan would then understand from figure 2 of *Haffner* that these depicted layers are not as thick as they are portrayed in the figure, and as such the skilled artisan would readily recognize that the structural panel of *Meckstroth* is provided for a completely different application than the floor covering panels of *Haffner*.

It is not entirely clear where or how the examiner proposes to apply the decorative layer of *Haffner* onto the structural panel of *Meckstroth*. Are the paper layers of *Haffner* to replace the inner or outer skins of the structural panel of *Meckstroth*, or are the paper layers to cover one or both of the inner or outer skins of the structural panel? No such explanation is provided in the action. Certainly, one skilled in the art would be required to account for the lack of structural strength of the paper layers of *Haffner* if they were to replace one of the inner and outer skins of *Meckstroth*, and particularly would require some motivation to cover the inner or

outer skins with the paper layers of *Haffner* since it presumed that they are already sufficiently durable to resist chemical, heat and abrasion resistance which was alleged in the action as being a motivating factor.

When considering the different purpose that the structural panel of *Meckstroth* serves over the floor covering panel of *Haffner*, the rationale for providing the decorative layer of *Haffner* on the structural panel of *Meckstroth* is nowhere to be found among the teachings of *Meckstroth* and *Haffner*. Instead, the basis provided in the action (e.g., providing the structural panel with an attractive appearance, and chemical, heat, and abrasion resistance) is based merely on speculation without any foundation in the prior art.

How exactly would one skilled in the art be motivated to provide a decorative layer of the type taught by *Haffner* along one of the skins of the structural panel of *Meckstroth* is anyone's guess. Certainly, there is no mention of the desirability of modifying the structural panel in *Meckstroth*, or even a hint of directly applying the decorative layer of *Haffner* to anything but a dimensionally stable core.

It is respectfully requested that the examiner provide some suggestion or evidence in *Meckstroth* and *Haffner*, or an understanding known to one skilled in the art that would indicate the motivation for providing the structural panel of *Meckstroth* with the decorative layer of *Haffner*.

As is well understood, *prima facie* obviousness can only be established if the combination of the prior art teaches all of the claimed limitations of claims. It is submitted that the combination of *Meckstroth*, *Haffner* and *Hendrich* does not disclose or suggest all of the required features according to the pending claims.

Contrary to the assertion in the action, *Meckstroth* does not teach a structural panel wherein mechanical coupling parts are defined along each of the four edges of the panel, and such coupling parts are arranged to lock with one another in vertical and horizontal directions. While the action points to features (20) and (30) of *Meckstroth*, it will be pointed out that feature (20) is an undercut recess that receives a

tubular bracket (30) (col. 2, lines 37-65). The undercut recess (20) is not a mechanical coupling part allowing for coupling in vertical and horizontal directions; the undercut recess of one structural panel cannot lock by itself with an adjacent undercut recess of another structural panel. Moreover, the tubular joint device (30) is in effect a separate component that secures adjacent structural panels, and provides a continuous internal force which draws the adjacent structural panels together (col. 1, lines 43-49).

There is clearly neither desirability in *Meckstroth* nor any desirability articulated in the action of providing mechanical coupling parts in the structural panel of *Meckstroth* that are defined along the edges of the structural panel and are arranged to lock with coupling parts of an adjacent structural panel.

It will be further pointed out that neither *Haffner* nor *Hendrich* disclose a floor panel having mechanical coupling parts defined along four edges arranged for coupling with one another in both vertical and horizontal directions. As for *Haffner*, in observing figures 9-11, a track locking strip (54) that is separate from the floor panels themselves is required to lock the panels in vertical or horizontal directions.

It is respectfully requested that the examiner address the shortcoming of the combination of *Meckstroth*, *Haffner* and *Hendrich* concerning the failure of these references to disclose or suggest the provision of mechanical coupling parts defined along four edges of a floor panel so the coupling parts can lock adjacent floor panels in both vertical and horizontal directions.

Next, while *Meckstroth* teaches that the structural panels may be provided in different widths or lengths, there is no suggestion by *Meckstroth* of providing sets with such differently sized panels in a single package, as required by the pending claims. *Meckstroth* merely indicates that the panels may be prefabricated in different widths or lengths (col. 2, lines 50-55), and cannot be construed to teach that these differently size panels may be provided in a set that includes panels of different dimensions.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the action, col. 2, lines 50-55, merely conveys that panels of different dimensions may be produced according to different applications such as “depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels.” From this passage, without the benefit of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panel may have a certain width that is different from the roof panels.

It is not understood what is meant in the response to the applicant’s previous remarks when the examiner refers to the fact that the pending claims do not recite a set of floor panels having different lengths. The examiner appears to further state that the applicant only recites floor panels of different lengths, and has argued that the set of floor panels is more limited than that which is actually claimed.

Claim 24 clearly recites that the floor panels of different lengths form part of a set of floor panels, and even more specifically that this set of floor panels is provided in a single package. Of course, such a set in a single package is not taught by *Meckstroth*, *Haffner* and *Hendrich*.

The applicant respectfully requests the examiner to clarify the examiner’s prior remarks since the applicant considers claim 24 to be abundantly clear as to the fact that a “set” is clearly claimed, the recited set includes floor panels having different lengths, and that the recited set is provided in a single package.

Lastly, it is submitted that the addition of *Hendrich* with the teachings of *Meckstroth* and *Haffner*, fails to convey to one skilled in the art the feature of the pending claims wherein the set of separate floor panels is provided in a single package. While *Hendrich* appears to be used in the combination as a supposed teaching that it would be obvious to “package building structures for transportation to a building site,” it is submitted that such a teaching does not amount to a prior art

teaching of the express limitation in the pending claims requiring that the set of floor panels is provided in a single package.

In the response to the applicant's prior remarks, the examiner appears to consider the structure taught by *Hendrich* as being irrelevant, and instead *Hendrich* is simply provided to demonstrate that it is known in the art to package items in kits in the building industry. While *Hendrich* may indeed be merely provided to show that it is known to package items in kits or sets in the building industry, the examiner provides no evidence other than conclusory statements to demonstrate how one skilled in the art would adopt this teaching of *Hendrich* in grouping with the proposed combination of *Meckstroth* and *Haffner*.

The applicant's prior remarks are meant to demonstrate that one skilled in the art would not be motivated to combine the teachings of *Hendrich* with those of *Meckstroth* and *Haffner*. While the applicant understands that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, the applicant also understands that the test for obviousness is whether the combined teachings of the references, when considered as a whole, would have suggested to one of ordinary skill the claimed invention. The applicant has shown in the prior remarks that upon considering the entirety of the teachings of *Hendrich*, one skilled in the art would not be motivated to combine the teachings of *Hendrich* with those of *Meckstroth* and *Haffner*.

Simply put in view of amended claim 24, there is no teaching of providing such individual modules and placing such individual modules in a "single" package or packages of any type. Furthermore, due to the sheer size of the structural building modules of *Hendrich*, as evidenced by the hingedly connected roof and floor elements and the description that such floor panels must be transported by rail or truck (col. 3, 14-17), it is clear that one skilled in the art would not understand from *Hendrich* the concept of providing sets of differently sized floor covering panels in a single package.

Despite the examiner's response to the applicant's prior remarks, the action still provides no grounds as to how one skilled in the art would be motivated to combine *Hendrich* with the teachings of *Meckstroth* and *Haffner*. Instead, there is a conclusory statement that one skilled in the art would have "appreciated packaging the materials in any convenient, efficient and low cost manner." This statement is rather speculative in nature, and lacks any articulated reasoning from the references themselves with some rational underpinning to support the conclusion of legal obviousness.

Therefore, it is respectfully requested that the examiner explain on the record how one skilled in the art would be motivated to combine *Meckstroth*, *Haffner* and *Hendrich* whether it be through the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art. As is well understood, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some objective reason to combine the references through a teaching, suggestion or motivation to do so either explicitly or implicitly in the references themselves, or in the knowledge of one of ordinary skill in the art.

The applicant submits that it has been shown from the foregoing remarks and the amendment to claim 24 that one skilled in the art would not be motivated to combine the teachings of *Meckstroth*, *Haffner* and *Hendrich* to arrive at the set of floor panels required by the pending claims. The recited set of floor panels of the pending claims possess advantages that were not appreciated by those skilled in the art at the time of the present invention was made.

Further, *Meckstroth*, *Haffner* and *Hendrich* each seek to solve different problems, and therefore there is no motivation to combine these references in the nature of the problem in which the references seek to solve. Specifically, *Meckstroth* is directed to providing an inexpensive and simple manner for joining adjacent structural panels with a joint device that is separate from the structural panels

themselves, and which forms a fluid-tight seal between adjacent structural panels (col. 1, lines 43-75). *Haffner* is directed to providing a method for forming an edge profile of a decorative laminate panel that is water resistant (col. 2, line 36 through col. 4, line 10). *Hendrich* is directed to solving the problem hingedly connected building modules (col. 2, lines 11-49).

None of the references in the proposed combination seek to provide a plurality of individual floor covering panels of different lengths, and each individual panel having coupling parts to lock to one another for forming one and the same floor covering. Thus, the nature of the problems to be solved by the combined references are unlike the solution provided in the pending application, and therefore one skilled in the art would not be motivated to combine the cited references on the basis of the nature of the problem to be solved.

When considering the pending claims of the application, it is widely understood that secondary considerations should be given attention. Indeed, the claims of the pending application present a specific manner for packaging a certain type of floor panels in the form of decorative floor covering panels that is not taught by the combination of prior art references. The manner for packaging the floor panels of the instant application departs from the traditional manner of packaging decorative floor panels of a same size in a single package. This results in the need for manufacturers to sell different packages of individual dimensions.

The pending claims recite a set that provides a mixture of different sized decorative floor panels in a single package. This provides significant benefits which are not foreseen by the prior art, including the proposed combination of *Meckstroth*, *Haffner* and *Hendrich*. These benefits address providing floor panels of at least two different sizes when installing a decorative floor covering, and mitigating the need for the installer to purchase an excess amount of floor panels of a certain size when few are required (specification on page 2, line 28 through page 3, line 5). It flows from

this benefit that there is a sufficient mixture of sized floor panels for the installer (specification on page 8, lines 4-15).

Another benefit is that the differently sized decorative floor panels of the set required by the claims allows for a distributor to only stock a few types of floor panels without much concern as to the sizes of the floor panels. A drawback in known methods of packaging decorative floor panels is that since the floor panels are sold in different lengths in different boxes, some sizes are sold in higher amounts than others. Since it is difficult for the distributor to anticipate the sales of different sizes, a mixture of sizes can be provided in a single package so as to reduce the overall stock of panels (specification on page 8, lines 17-26).

Because *Meckstroth* and *Hendrich* relate to structural panels or other structure for building construction, and further because there is an overall absence of the concept of decorative floor packaging in *Haffner*, one skilled in the art would not appreciate the benefits presented by the manner of the pending claims for packaging decorative floor panels. Further, due to the advantages provided by decorative floor packaging of the pending claims, it is clear that the subject matter of the pending claims is not obvious in view of the prior art, inclusive of the proposed combination.

In the view of these observations, it is submitted that the proposed combination of *Meckstroth*, *Haffner* and *Hendrich* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover, there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed combination to devise the set of packaged decorative floor panels according to the pending claims. Accordingly, withdrawal of the rejection is respectfully requested.

Application No.: 10/753,453
Examiner: CHAPMAN, Jeanette
Art Unit: 3635

3. Conclusion

As a result of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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